

REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

SUBSTITUTE ABSTRACT

The Abstract of the Disclosure has been objected to for the reasons given at the top of page 2 of the Detailed Action. The Abstract has been amended to reflect the simplest and most direct description of the invention. In the event that the present replacement Abstract itself is found not to be of proper form, the Examiner is herein authorized to amend to a suitable replacement Abstract.

CLAIM OBJECTIONS OBLIVIATED VIA CLAIM CANCELLATION

Claim 1 was objected to because of the concerns listed mid-page on page 2 of the Detailed Action. As Claim 1 has been canceled (without prejudice or disclaimer), reconsideration and withdrawal of the claim objection are respectfully requested.

ALLOWABLE CLAIMS

As indicated at mid-page on page 6 of the Detailed Action, Claims 7-9 were indicated as being allowable if rewritten to include all of the limitations of the base and intervening claims. Since appropriate ones of such claims have been rewritten, renewal of the indication of allowance is respectfully requested. Applicant and the undersigned thank the Examiner for such indication of allowable subject matter.

PENDING CLAIMS

Claims 1-9 were pending in the application, under consideration and subject to examination at the time of the Office Action. Unrelated to any prior art, scope or rejection, appropriate Claims have been amended, added or deleted in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 7-19 are now pending in the application for consideration and examination.

REJECTION UNDER 35 USC §103 - TRAVERSED

The 35 USC §103 rejection of Claims 1-6 as being unpatentable over Emo *et al.* (US 6,091,559 A) in view of Hirano *et al.* (US 6,504,663 B2) is respectfully traversed. Unrelated to any prior art, scope or rejection, Claims 1-6 have been canceled herein (without prejudice or disclaimer), which has rendered the rejection of such claims and traversal arguments obsolete at this point in time. Applicant respectfully submits the following to preclude any rejection directed to the claims remaining upon entry of this paper.

All descriptions of Applicants disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

As set out in the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), the court points out that the PTO has the burden under §103 to establish a *prima facie* case of obviousness, and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Furthermore, such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is “basic knowledge” or “common knowledge.” The Court pointed out:

The Examiner’s conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of reference, simply to “[use] that which the inventor taught against its teacher.” ...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.
(emphasis added)

Therefore, in order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited prior art does not adequately support a §103 obviousness-type

rejection because it does not, at minimum, disclose (or suggest) the following limitations of Applicant's clarified claims.

Applicant's disclosed and claimed arrangements are directed to servo-write arrangements to self-record servo signals onto magnetic disk arrangements. Such arrangements serve, for example, to: write a recording region detecting signal on the magnetic disk on which no positional signal is recorded, by turning on a write current during a predetermined period when the magnetic head is moved from a load/unload path onto an area on a first periphery of said magnetic disk; move said magnetic head to a opposite periphery of said magnetic disk from said first periphery, until an actuator hits a stopper defining said opposite periphery of said magnetic disk; record a propagation-purpose pattern which is used to determine a magnetic head position when a servo signal is recorded later in a radial direction, by moving said magnetic head at a predetermined feed pitch until said recording region detecting signal is detected, said feed pitch being determined so as to correspond to a predetermined rate of level of said propagation-purpose pattern detected just after the propagation-purpose pattern is written by said magnetic head; calculate a pitch of head feeding for writing a product-purpose servo signal by which said magnetic head can be located at a certain track in order to write/read information, on a basis of amounts of head feeding from said opposite periphery to a point where said recording region detecting signal is recorded and a number of tracks; and record said product-purpose servo signal sequentially onto a predetermined area between a position of said opposite periphery of said magnetic disk and a position at which said recording region detecting signal is recorded.

Turning now to rebuttal, the applied art (taken singly or in combination) would not have disclosed or suggested the above features/limitations of Applicant's claims. More particularly, in contrast to servo-write arrangements to self-record servo signals onto magnetic disk arrangements on which no positional signal is recorded, both Emo *et al.* and Hirano *et al.* have servo signals already recorded thereon.

Applicant's disclosed and claimed invention discloses unique and novel arrangements (e.g., operations) to record a region detecting signal against a load/unload path, and then measure and use the space between an opposing stopper and the recorded region detecting signal to self-record servo signals onto the magnetic disk.

In addition to the foregoing, the following additional remarks from Applicant's foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant's claims.

The present invention relates to a self servo-write method in which the outermost peripheral edge of an area for recording a product-purpose servo signal or servo pattern is determined without using a stopper defining the outermost peripheral edge or an external writing device. In the present invention, instead of using a stopper, a recording region detecting signal is recorded on a magnetic disk on which no positional signal is recorded by turning on a write current during a predetermined period when a magnetic head is moved from a ramp road onto an area on a disk. The magnetic head is then moved to an inner periphery of the magnetic disk until an actuator hits a stopper defining an innermost periphery of the magnetic disk. When a servo signal is recorded in a radial direction, a propagation-purpose pattern which

is used to determine a magnetic head position is recorded by moving the magnetic head at a predetermined feed pitch until the recording region detecting signal is detected. The feed pitch is determined so as to correspond to a predetermined rate of level of the propagation-purpose pattern detected just after the propagation-purpose pattern is written by the magnetic head, *i.e.*, writing, detecting and measuring the propagation-purpose pattern is successfully performed to determine the feed pitch. A pitch of head feeding, for writing a product-purpose servo signal or servo pattern by which the magnetic head can be located at a certain track in order to write/read information, is calculated on the basis of mounts of head feeding from an inner periphery to an outer periphery and a number of tracks. The product-purpose servo signals are then sequentially recorded onto a predetermined area between a position of the innermost periphery of the magnetic head and a position at which the recording region detecting signal is recorded.

On the other hand, in Emo *et al.*, as shown at 1202 in Fig. 12C, the servo information is already recorded using an external writing device (see, *e.g.*, Col. 7, line 54-57 of Emo *et al.*). As well, in Hirano *et al.*, the signals in area 84 also are already recorded.

Neither of the applied references teaches or suggests the claimed invention.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejection, and express written allowance of all of the rejected claims, are respectfully requested.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, i.e., Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

A Petition for extension of time is being concurrently with this paper. To whatever other extent is actually necessary, Applicant respectfully petitions the

SUGIYAMA *et al.*, SN 10/075,234
Amdt. dated 11/26/2004
Reply to OA mailed 07/26/2004

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Commissioner for an extension of time under 37 CFR §1.136. A Form PTO-2038

also is attached in payment of the requisite Petition and additional claim fees.

Please charge any actual deficiency in required fees to ATS&K Deposit Account No. 01-2135 (as Case No. 500.41195X00).

Respectfully submitted,



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Attachments:

Petition For Extension Of Time
Form PTO-2038 (Fee Codes 1201/1251)